



30 NOV 2006

24197
KLARQUIST SPARKMAN, LLP
121 SW Salmon Street
Suite 1600
Portland, OR 97204

In re Application of :
IKIADES *et al* :
U.S. Application No.: 10/560,755 :
PCT No.: PCT/GB2003/002600 :
Int. Filing Date: 17 June 2003 :
Priority Date: 13 June 2002 :
Attorney Docket No.: 7429-72784-01 :
For: ICE DETECTION APPARATUS AND :
METHOD :

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.47(a) for Unavailable Inventor" filed 11 September 2006.

BACKGROUND

On 30 March 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) & (b) was required. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 11 September 2006, applicants filed a response to the Form PCT/DO/EO/905 which was accompanied by, *inter alia*, a petition under 37 CFR 1.47(a); a four-month extension and fee; the petition fee; a declaration executed by three of the four named inventors; and a statement in support of filing on behalf of an unavailable inventor ("Decl.").

On 03 November 2006, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) and filing receipt indicating completion of all 35 U.S.C. 371 requirements.

DISCUSSION

The Form PCT/DO/EO/903 and filing receipt mailed 03 November 2006 were mailed in error and are hereby **VACATED**. All requirements of 35 U.S.C. 371 have not yet been completed.

Petitioner claims that one of the joint inventors, George Graham Hare, could not be located and submitted a declaration signed on his behalf by the other three joint inventors along with a petition under 37 CFR 1.47(a). A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the petition fee has been paid.

With regards to item (3), the last known address of George Graham Hare is listed as:

5 Mayfield Close
Shipton Bellinger, Tidworth
Hampshire SP9 7YG
England

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by three of the four named inventors on their own behalf and on behalf of the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), section 409.03(d) of the MPEP discusses situations where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is

important that the statement contain facts as opposed to conclusions.

Applicant submitted a statement of facts by Simon J. Robinson, an attorney representing the assignee. Mr. Robinson states that a co-inventor, Mr. Armstrong, indicated that Mr. Hare left the employ of Aerospace and moved to New Zealand and did not provide a forwarding address. Decl. at ¶ 3. Mr. Robinson states that he conducted several internet searches and telephoned the New Zealand White Pages to find Mr. Hare's current address, but was unsuccessful. *Id.* at ¶ 4-5. No other evidence was provided.

This evidence alone is insufficient to show that a "diligent effort" was made to locate the nonsigning inventor. A statement of facts by Mr. Armstrong who has first-hand knowledge of Mr. Hare's situation is required. Moreover, petitioners must submit documentary evidence of the internet searches and telephone calls used to claim that a diligent effort was made to locate the nonsigning inventor.

For these reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302